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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,120	06/08/1999	JOHN R. LOVELL	SLP-005-(722	6363

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EXAMINER

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ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 09/328,120
Filing Date: June 08, 1999
Appellant(s): LOVELL ET AL.

Kevin Carroll
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11-24-03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 19-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Art Unit: 3761

(8) Claims Appealed

A substantially correct copy of appealed claims 19-29 appears on page 8 of the Appendix to the appellant's brief. The minor errors are as follows: in claim 23, the claim should read "the seal of claim 22 wherein a thickness of the bladder"....

(9) Prior Art of Record

3,725,953

Johnson, et al.

04-1973

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19-29 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 24.

(11) Response to Argument

The argument that the examiner erred in relying on obvious design choice for modifying Johnson to include material in the bladder of the claimed durometer is not persuasive. The office maintains that absent disclosed criticality, absent the solving of a stated problem, and absent a stated purpose, that differences between the prior art and the claimed invention are considered to be obvious design choices and will not support a conclusion of patentability or non-obviousness if the prior art would perform equally as well as the applicant's. The purported problem solved by the applicant's seal is not specific to the claimed durometer. The applicant did not state how a material within the claimed durometer would provide a comfortable improved seal relative to materials outside the claimed durometer. A vague statement of comfort and reliable sealing by the seal of the applicants is hardly a statement of either criticality or problem solving as the

prior art has examples of these same attributes using materials without the disclosed softness. Note col. 1 lines 56- col. 2 line 3 and col. 3 lines 11-23 of Johnson which detail that Johnson's seal is easily compressible to comfortably fit a variety of facial contours for long periods of time while sealing the mask's interior. Since these attributes are the same reasons noted by the applicant, it is the examiner's position that the prior art seal would perform equally as well as the applicants. Is it the applicant's position that seals outside the claimed durometer would cease to be comfortable or seal in a reliable manner for extended periods of time? Clearly Johnson, which applicant maintains is outside the claimed durometer, provides these same benefits.

The argument that the prior art teaches away from the claimed modification is also not persuasive. The examiner is not maintaining that it would have been obvious to place a gel inside tube 21. The examiner maintains that it would have been obvious to have formed the tube 22 out of material within the claimed durometer. There would be no danger of the soft tube 22 being expelled out ports 22a as maintained by the applicant. Additionally, the Barnett seal is not particularly relevant to the seal of Johnson and lacking particular relevance cannot be said to teach away from the purported modification of the Johnson seal. Barnett teaches that it would not be obvious to make the seal as a whole to be of the same resilience as human fat tissue. The bladder of Barnett acts as nothing more than an enclosure essentially providing a negligible change in durometer over the gel therein-see col. 5 lines 18-32. In contrast thereto, Johnson includes as an important component of the seal, an outer "layer of pliable neoprene" wrapped around the tubing 22. The two components as a whole make up the

Art Unit: 3761

seal having the recited characteristics. Therefore placing a tube 22 made out of material having the claimed durometer inside the tube 21 of Johnson would not provide a seal as a whole having the claimed durometer... i.e. the durometer of the seal of Johnson, once modified as the examiner contends, would have an overall seal of a durometer higher than that of only the material of tube 22. Noting these differences, the examiner contends that the Barnett reference is not particularly relevant to the rejection at hand, and therefore does not provide a teaching away of the claimed subject matter. For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3761

Respectfully submitted,

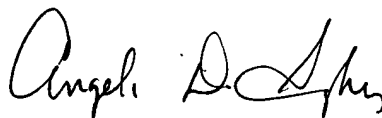


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Primary Examiner
Art Unit 3761

gkd
March 18, 2004

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